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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,910	04/26/1999	NORIYOSHI SONETAKA	Q54131	2573

7590 04/06/2004

SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 200373202

EXAMINER
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WEST, LEWIS G

ART UNIT	PAPER NUMBER
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2682

28

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/298,910

Applicant(s)

SONETAKA, NORIYOSHI

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,12,14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,12,14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments filed February 18, 2004 have been fully considered but they are not persuasive. It is unpersuasive for applicant to add limitations and then argue a rejection under USC 102 that was proper before the limitations were added for the purpose of overcoming the rejection. Claims 10 and 16 now recite processing at the base station control station; this basic concept has been repeatedly, and properly, rejected in other claims. Claims 12, 14 and 17 now cite new matter, see below. Applicant's now disclose "single" digits being sent, which is clearly shown in Bilgic. Also using "single digit" dialing is not in the original claims or specification, and is therefore also new matter. All arguments related to this new matter are moot, as it must be removed.

***Specification***

2. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

3. Claims 10, 12, 14, 16 and 17 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant did not describe processing of digits individually or at all in an exchange in the original specification. This is new matter and must be removed, as applicant may not add new matter to overcome prior art.

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Correction is required. For examination, claims 12, 14 and 17 will be treated as unamended, as the currently claimed subject matter was not specified.

Regarding claims 10, 12, 14, 16 and 17 are also rejected as containing new matter, the limitation, "received single digit" and "single digit dialing" are not contained in the original specification or claims and must be removed, as they are new matter.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10, 12, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilgic (US 5,884,148) in view of Suonvieri (6,047,181).

Regarding claim 10, Bilgic discloses a radio access system comprising: means for producing dialing signals comprising a telephone set having a dial pad with keys, wherein a single digit dialing signal is generated when a key of said dial pad is pushed (col. 10 line 22-col. 11 line 24); a base station control (113) station in radio communication with said means for producing dialing signals through a base station; means for transmitting the single digit dialing signal to said base station each time a single digit dialing signal is generated (col. 11 lines 8-24), said base station including means for deciding whether a received single digit dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at

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the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 12, Bilgic discloses a radio access system comprising: means for producing dialing signals (col. 10 line 22-col. 11 line 24); means for transmitting the dialing signals each time they are produced (col. 11 lines 8-24) and a base station in radio communication with said means for producing dialing signals (col. 11 line 25-38), said base station including means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) wherein said means for producing dialing signals includes a telephone set having a dial pad with keys, a dialing signal being generated when a key of said dial pad is pushed (col. 11 line 39-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 14, Bilgic discloses a radio access system comprising: means for producing dialing signals (col. 10 line 22-col. 11 line 24); means for transmitting the dialing signals each time they are produced (col. 11 lines 8-24) and a base station in radio communication with said means for producing dialing signals (col. 11 line 25-38), said base station including means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) wherein said means for producing dialing signals includes a telephone set having a dial pad with keys, a dialing

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signal being generated when a key of said dial pad is pushed (col. 11 line 39-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 16, Bilgic discloses a radio access method comprising the steps of: producing a single digit dialing signal when a key of a dial pad is pushed; transmitting each single digit dialing signal to a base station each time they are produced; and deciding at said base station whether a received single digit dialing signal represents a final digit of a dialed telephone number or not. (Col. 11 lines 8-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 17, Bilgic discloses a radio access method comprising the steps of: producing dialing signals when a key of a dial pad is pushed; transmitting dialing signals each time they are produced; and deciding at a base station control station whether a dialing signal represents a final digit of a dialed telephone number or not. (Column 11) Bilgic does not expressly disclose digit analysis in the base station control

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station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 703-308-9298. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lewis West  
(703) 308-9298  
March 22, 2004



VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
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4/5/04